DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 09 January 2010.

2. Claim 1 has been amended.

3. Claims 1-5 and 22-25 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

   rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

   (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ken Hayward et al

   (HAYWARD)(United States Patent 6,798,997 B1).

   Claim 1:

   HAYWARD teaches: A computer implemented method comprising: Col 4 lines 10-20

receiving data, at a server electronic device, from a client electronic device upon an occurrence of an

event, wherein the data comprises an inventory of components installed at the client electronic device,

and wherein the data further comprises a plurality of fields,

See at least Col 6 lines 1-13; "...particular condition to the user, for example on a display screen..." Col 5 lines 15-22 See also Figs 3 and 4 See also "...inventory..." Col 8 lines 35-55 See also "...fields..." Col 4 lines 45-55

and wherein the event is selected from a group consisting of installation of hardware at the client electronic device, installation of software at the client electronic device, detection of a performance problem at the client electronic device, and detection of an error at the client electronic device;

See at least "...error conditions..." Col 1 lines 20-37; See also Col 6 lines 1-13

saving the data at the server electronic device

See at least "...information may be entered and saved in computer 30 during online registration and modified, if necessary..." Col 8 lines 15-17; See also the program in computer 30 receives the peripheral condition from the firmware and checks to see if the information is stored in the memory of computer 30, if not it requests the information from the manufacturer server over the internet, this indicates that the condition data is stored at least at either the computer 30 or the manufacturer server Col 6, lines 34-56; See also "the latest information on the registered machine may be stored in the computer 30 Col 4, lines 60-61

comparing, at the server electronic device, a subset of the plurality of fields to a plurality of thresholds via a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the plurality of thresholds to values in subset of the plurality of fields,

See at least "...consumable has reached a predetermined threshold..." Col 8 lines 25-45 See also "...threshold conditions..." Col 9 lines 25-33 "...upon identification of a threshold condition..." Col 2 lines 20-25 "...the condition may be used to indicate when a consumable has been exhausted (paper tray empty) or a consumable has reached a predetermined threshold (e.g. magenta ink level low)..." Col 8 lines 25-30

and specify an associated recommended offering,

See at least Col 9 lines 50-60 "...the marking apparatus may be programmed to communicate an offer to purchase a consumable component..." See also Col 2 lines 45-51 "...the imaging apparatus

automatically electronically communicates an offer to purchase a replacement part for the replaceable part upon occurrence of a defined threshold condition…"

wherein the subset of the plurality of fields of the data comprises a trend at the client electronic device, wherein the trend comprises a rate of growth of consumption of a resource at the client electronic device and an estimated time period until the resource is constrained,

See at least "…supply, wear, usage, rate of depletion, rate of wear, predicted date of depletion of supply…predicted ate of need of consumable component…statistical data for consumable component…"

and wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period;

"…rate of depletion…predicted date of depletion of supply…" Depletion represents increased wear, use of the consumable. Col 9 lines 25-33

and when the plurality of conditions are met by the comparing of the values in the subset of the plurality of fields to the plurality of thresholds, sending the associated recommended offering and an identification of a marketing channel computer from the server electronic device to the client electronic device and sending a notification to the marketing channel computer,

"…the sensor and software system automatically offers to purchase a replacement for the cartridge upon identification of a threshold condition in the cartridge…" Col 2 lines 60-65 See also Col 10 lines 30-41 See also "…the marking apparatus may electronically initiate a purchase offer, electronically receive an acceptance of the purchase offer, and electronically form a contract with a supplier for purchase of the replaceable part or consumable component…" Col 9 lines 43-45

wherein the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering,

Col 6 lines 1-13 See at least "…explained as "Magenta Ink Level Low"…" See also "…Pressing the "Show me" button…" Col 6 lines 1-13

and wherein the client electronic device displays the associated recommended offering via an output

device,

   See at least "…the browser displays the screen to the user, the user selects such online purchasing

options…" Col 7 lines 60-67

      Examiner considers "wherein the data comprises and inventory of components installed at the

client electronic device" and "wherein the information regarding why the recommended offering was made

comprises a subset of the data that explains a reason for a need for the recommended offering" to be

nonfunctional descriptive material, yielding no patentable weight.

Claim 2:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein

the associated recommended offering further comprises an offer for a service.

   See at least: "…selected service..." Col 5 lines 34-40; Col 5 lines 50-55

Claim 3:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein

the data comprises a hardware inventory of the client electronic device.

   See at least Col 7 lines 1-5; Col 8 lines 35-40

Claim 4:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein

the data comprises a software inventory of the client electronic device.

   See at least Col 4 lines 10-15; Col 8 lines 35-40

Claim 5:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein

the data comprises a performance inventory of the client electronic device.

   See at least Col 7 lines 45-50; Col 8 lines 35-40

Claim 22:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: further comprising: saving a history of the inventory as the inventory changes over time. <u>See at least Col 8 lines 35-40</u>

Claim 23:

HAYWARD teaches: The method of claim 22 as discussed above and further discloses: wherein the comparing further comprises: comparing a plurality of records in the history. <u>See at least Col 7 lines 30-35</u>

Claim 24:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein the associated recommended offering comprises an offer for hardware.

<u>See at least Col 2 lines 45-50</u>

Claim 25:

HAYWARD teaches: The method of claim 1 as discussed above and further discloses: wherein the receiving further comprises: periodically receiving updates to the data from the client electronic device.

<u>See at least Col 7 lines 35-40; See also Col 2 lines 45-50</u>

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

      2.   Ascertaining the differences between the prior art and the claims at issue.

      3.   Resolving the level of ordinary skill in the pertinent art.

      4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-5 and 22-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suellen Kae Birkholz et al (<u>BIRKHOLZ</u>)(US 7,055,149 B2) in view of Peter Roy Ballantine et al (<u>BALLANTINE</u>)(US 6,446,123 B1).**

Claim 1:

<u>BIRKHOLZ</u> teaches: A computer implemented method comprising:

See at least "...Fig 1 is a diagram of a networked environment generally defining a relationship between a computer system customer/owners side and a computer system supplier side...The computer systems may be any computerized device including personal computers (PCs), workstations, servers, wireless devices, personal digital assistants (PDAs), and the like..." Col 4 lines 50-67; see also Fig 1

receiving data, at a server electronic device, from a client electronic device upon an occurrence of an event, wherein the data comprises an inventory of components installed at the client electronic device, and wherein the data further comprises a plurality of fields,

See at least Fig 38; See also "...receiving, by a supplier system, a **software inventory [inventory of components]** from the customer system..." Col 2 lines 15-17 See also "...the software sales representative must determine the software inventory currently installed on the customer system..." Col 1 lines 45-47   See also "...machine software inventory is sent directly from the selected hardware of the customer system as directed by the customer..." Col 28 lines 60-65   See also "...The GUI may have a variety of fields with default entries compiled from customer/product registration information..." Col 32 lines 44-50

and wherein the event is selected from a group consisting of installation of hardware at the client electronic device, installation of software at the client electronic device, detection of a performance problem at the client electronic device, and detection of an error at the client electronic device;

> See at least "…a method for collecting information on the installed software on the customer's
> machine and processing the collected information in a supplier system…" Col 2 lines 23-26 See also
> "…performance data…" Column 19 lines 19-32 See also Fig 12 See also "…the customer machine
> information database contains customer supplied information about specific computers. For each
> particular computer, such information may include a model number, a machine type, a plant code,
> hardware information (for various devices resident on the computer)…" Col 19 lines 7-12 See also
> "…display error messages…" Col 23 lines 45-50

saving the data at the server electronic device

> See at least column 4, lines 56-67 and column 5, lines 1-7, the computer system includes a
> performance database in which performance data is stored and eventually exported to suppliers

comparing, at the server electronic device, a subset of the plurality of fields to a plurality of thresholds via

a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the

plurality of thresholds to values in subset of the plurality of fields, and specify an associated

recommended offering,

> See at least "…the system sizer employs a system model selection function, referred to as the
> comparison tool, to construct the set of all systems capable of meeting the system capacity
> requirements…" Col 7 lines 45-50   See also Fig 9 and Col 12 lines 17-41   See also
> "…recommendation table…" Col 12 lines 1-16

wherein the subset of the plurality of fields of the data comprises a trend at the client electronic device,

wherein the trend comprises a rate of growth of consumption of a resource at the client electronic device

and an estimated time period until the resource is constrained,

> See at least "…memory growth trend field…" Col 15 lines 25-30 See also "…estimated system
> attributes entry and a time period entry…" Col 12 lines 5-6

and when the plurality of conditions are met by the comparing of the values in the subset of the plurality of

fields to the plurality of thresholds, sending the associated recommended offering and an identification of

a marketing channel computer from the server electronic device to the client electronic device and

sending a notification to the marketing channel computer, wherein the notification comprises a request to receive information regarding why the recommended offering was made,

> See at least Fig 38 element 3830 "Why should I use IBM Electronic Services FRO AS/400? See at least Fig 18 and "...a system recommendation GUI. The GUI contain system recommendation information resulting from the recommend table and which will be passed to the comparison tool..." Col 15 lines 50-67

and wherein the client electronic device displays the associated recommended offering via an output device.

> See at least Fig 38 element 3830 "Why should I use IBM Electronic Services FRO AS/400? See at least Fig 18 and "...a system recommendation GUI. The GUI contain system recommendation information resulting from the recommend table and which will be passed to the comparison tool..." Col 15 lines 50-67

Examiner considers "wherein the data comprises and inventory of components installed at the client electronic device" and "wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering" to be nonfunctional descriptive material, yielding no patentable weight.

In general, __BIRKHOLZ__ teaches a system and method for automating software upgrades

Although __BIRKHOLZ__ teaches a system and method for automating software upgrades, **nevertheless,** __BIRKHOLZ__ does not expressly disclose and wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period; or wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering,

HOWEVER, __BALLANTINE__ does teach and wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period; or wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering,

(See at least **BALLANTINE** "...details reasons impact and recommended actions time to threshold estimated time to fix..." Fig 3 elements 330, 310 and 340 See also Col 6 lines 28-35; Col 6 lines 40-47)

THEREFORE, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the teachings of **BALLANTINE** with **BIRKHOLZ** so as to provide a system and method to provide recommendations based on increasing constraints on system components **thereby** allowing for users to repair computer components before approaching failure or capacity in order to prevent discontintinuance or interruption of a user's use of computer.

Claim 2:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the associated recommended offering further comprises an offer for a service.

See at least Col 24 lines 55-60

Claim 3:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the data comprises a hardware inventory of the client electronic device.

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also "...performance data..." Column 19 lines 19-32 See also Fig 12 See also "...the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)..." Col 19 lines 7-12 See also "...display error messages..." Col 23 lines 45-50

Claim 4:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the data comprises a software inventory of the client electronic device.

See at least "...a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system..." Col 2 lines 23-26 See also

"…performance data…" Column 19 lines 19-32 See also Fig 12 See also "…the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)…" Col 19 lines 7-12 See also "…display error messages…" Col 23 lines 45-50

Claim 5:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the data comprises a performance inventory of the client electronic device.

See at least "…a method for collecting information on the installed software on the customer's machine and processing the collected information in a supplier system…" Col 2 lines 23-26 See also "…performance data…" Column 19 lines 19-32 See also Fig 12 See also "…the customer machine information database contains customer supplied information about specific computers. For each particular computer, such information may include a model number, a machine type, a plant code, hardware inforamtion (for various devices resident on the computer)…" Col 19 lines 7-12 See also "…display error messages…" Col 23 lines 45-50

Claim 22:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: further comprising: saving a history of the inventory as the inventory changes over time.

See at least "…at some time interval (monthly) the historical summary server operates to merge the summarized agent data with older history data (previously collected from the same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

Claim 23:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 22 as discussed above **BIRKHOLZ** further discloses: wherein the comparing further comprises: comparing a plurality of records in the history.

See at least "...at some time interval (monthly) the historical summary server operates to merge the summarized agent data with older history data (previously collected from the same computer system) Col 6 lines 35-56 See also fig 6 and Col 10 lines 40-52

Claim 24:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the associated recommended offering comprises an offer for hardware.

See at least Col 17 lines 1-7

Claim 25:

BIRKHOLZ and **BALLANTINE** teach: The method of claim 1 as discussed above **BIRKHOLZ** further discloses: wherein the receiving further comprises: periodically receiving updates to the data from the client electronic device.

See at least Col 7 lines 1-16

Response to Arguments

8. Applicant's arguments filed 09 January 2010 have been fully considered but they are not persuasive. With respect to the 102 rejection Applicant argues that the Hayward invention does not anticipate Applicant's claimed invention because Hayward "does not teach or suggest 'comparing, at the server electronic device, a subset of the plurality of fields...' because it is the Hayward peripheral 10 that detects the conditions which 'indicate[s] when a consumable has been exhausted,' and the Hayward computer 30 merely accesses an address defined by the peripheral condition, but the Hayward computer 30 does no comparing, as recited in claim 1" (see page 10 of Applicant's remarks). There are at least two situations in which Hayward specifically teaches comparing detected circumstances to threshold levels. In at least column 8, lines 33-45, the inventory sub-module receives and records and tracks consumable inventory and compares consumable inventory levels to thresholds. Examiner notes that this module is part of the application program running in computer 30. Further see column 6, lines 34-38, when the application receives information from the peripheral device, it checks the memory to see if information in response to the particular condition is in memory, and only if the

information is not in memory does the application use the internet to present the detected condition to the server to elicit the appropriate information. Applicant's argument that computer 30 merely accesses an address defined by the peripheral condition is inaccurate. As demonstrated, computer 30 receives data indicating inventory level and other peripheral conditions, scans memory, and tracks and saves changes in peripheral device consumable inventory depletion in view of programmed thresholds. Examiner's interpretation of the claimed "comparing" limitation is based on the disclosure which teaches receiving condition data, and "comparing" the data to stored thresholds. Accordingly Hayward disclosure anticipates the claim to comparing and further the Hayward computer 30 device performes the "comparing" features contrary to Applicant's arguments. The rejection is therefore maintained.

9. With regard to the 103 rejection, Applicant argues that "no suggestion exists to combine Birkholz with Ballantine because to do so would destroy the function of Birkholz and render Birkholz inoperable" (see page 12 of Applicant's remarks). Applicant asserts that "[c]ombining Birkholz with Ballantine would <u>require the Birkholz estimated system to be ordered, received, configured and operated until the Ballantine component performance exceeds its threshold, so that the Ballantine warning alert could be generated and then escalated as the Ballantine predetermined period gets closer</u>" (*Id.*). Applicant suggests that because Birkholz is a system designed to estimate or anticipate needs based on usage, there is not room in a Birkholz system for a Ballantine-style warning alert that results from a threshold condition occurring. Applicant further asserts that modifying a Birkholz system to include a warning or alert would destroy the functionality and purpose of the Birkholz invention and therefore Examiner's 103 rejection is improper. Examiner is not persuaded by this argument. First off the concerns Applicant highlights, including specific passages of Ballantine, are not relevant to the rejection. Second, 103 obviousness rejections are not assertions by Examiner that an invention disclosed in the primary reference is physically combined with an invention disclosed in the secondary reference as Applicant suggests. The purpose of the obviousness rejection is to indicate to Applicant that a feature of Applicant's claims is distinguishable from the primary reference; however that distinction is not patentable because the feature would have been obvious to one having ordinary

skill in the art at the time of the invention. The above rejection relies on a teaching in Ballantine to demonstrate to Applicant that the claim limitations directed to "one of the plurality of conditions specifies a determination whether the trend at the client electronic device is increasing during the estimated time period [and] the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering" were obvious to one having ordinary skill in the art at the time of the invention. Specifically The rejection recognizes that the Birkolz invention makes determinations based on conditions perceived by the system, the Birkolz disclosure does not specifically disclose whether certain conditions "specify" trends or information regarding why the recommended offering was made. However Examiner does not find these limitations to be patentable distinctions because any one of ordinary skill in the art that is at least familiar with Birkholz would understand that conditions such as paper use or ink well depletion are trends which increase as the inventories approach a fully depleted threshold. Further one of ordinary skill in the art readily knows why an offering to replace depleted supplies or supplies about to be depleted would be made. Examiner points to Ballantine's specific teaching of a system that details these reasons to prove to Applicant that these features are obvious to one having ordinary skill in the art at the time of the invention. Contrary to Applicant's argument, Applicant does not suggest any modification to the Birkholz invention in examiner's 103 rejections, let alone a modification that would destroy the operability of the Birkholz invention. The rejection is maintained because it properly presents the Birkholz disclosure which teaches the invention detailed in Applicant's claims, except for the obvious features known to those of skill in the art as demonstrated by the Ballantine reference.

10. Applicant also argues that neither Birkholz nor Ballantine disclose "the notification comprises a request to receive information regarding…" (see page 13 of Applicant's remarks). As noted in the rejection above, the specific data claimed is disclosed by Ballantine in Figure 3, column 6, lines 28-35 and 40-47. Further as Applicant notes (page 14 of Applicant's remarks), Examiner is not convinced that the specific content of data, i.e. the reason why the recommended offering was made" functionally effects the scope of a claim directed to receiving data. Based on Examiner's

interpretation, any system capable of receiving data as claimed is not a novel or non-obvious system because the data received varies. Applicant points out that "sending" is functional language (see page 15 of Applicant's remarks), and Examiner agrees. However the specific content of what data is sent or received is not necessarily functional. Applicant explains that the specific data content is "part of the definition of the notification," here Applicant admits that this limitation is merely descriptive information. The notification itself is data; therefore Applicant admits that the data in this limitation is merely descriptive of data. The question for Examiner is whether the notification data, and a description of the notification data, functionally and patentably effects the scope of the invention. Applicant argues that it does merely because this information is sent or received and sending and receiving are functional limitations. Examiner is not convinced. Examiner maintains that the limitations are non-functional descriptive material and that they do not effect the scope of the claim – specifically they do not effect the scope of the sending/receiving limitations. Despite this interpretation, Examiner has examined these limitations and demonstrated their disclosure in the prior art. Examiner is confident that Examiner's interpretation is reasonable and appropriate and that the rejection is reasonable, accurate and complete.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

15. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

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or faxed to **571-273-8300**.

16. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622
11/6/2010

/Arthur Duran/
Primary Examiner, Art Unit 3622